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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/040,825	03/18/1998	MARIO FRYBERG	ICH275	2298

25230 7590 12/19/2002

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EXAMINER
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YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/040,825

Applicant(s)

FRYBERG ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 December 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 3, 4 and 6-13 for reasons of record.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_  
10. ☐ Other: \_\_\_\_\_

MEY  
12/18/02

Continuation of 5. does NOT place the application in condition for allowance because statements regarding unexpected results must be supported by an appropriate affidavit or declaration. Although the data presented in the "Remarks" of applicants' reply is not supported by an affidavit or declaration, the examiner has considered the data and notes the following:

The general structure set forth in claims 12 and 13 encompasses more than one specific copolymer. Smigo et al. also disclose more than one specific copolymer. In stating that Coating 3 contains Smigo's copolymer which is the same copolymer claimed in the application, the exact identity of the copolymer is not clear.

During the telephonic interview with applicants' representative on 08 August 2002, the examiner indicated a willingness to reconsider the patentability of the portion of the claimed subject matter where R=alkyl with 1-6 carbon atoms if objective evidence was presented demonstrating superior/unexpected results for a copolymer where R=alkyl with 1-6 carbon atoms versus a copolymer where R=H. It is not clear from the information provided in applicants' response if the data include a comparison between a copolymer of the claimed general formula where R=H versus a copolymer of the claimed general formula where R=alkyl with 1-6 carbon atoms.

It is the examiner's position that the data also demonstrate why the "enhanced light fastness properties" limitation of the present claims renders the claims indefinite. The claims do not specify the comparison point for determining whether a particular recording sheet comprising the layer has enhanced light fastness properties, and the scope of light fastness properties is not clearly set forth. The data presented in Tables 2-5 in applicants' response demonstrate that whether a recording sheet comprising a layer according to present independent claim 12 has enhanced light fastness properties as measured by visual loss in % of initial density depends upon factors such as the recording sheet being used as the comparison, the total illumination to which the sheet is exposed and the type of printer and/or inks used to print the sheets (it is not clear if the "original inks" used for the two printers were the same). For example, when exposed to a total illumination of 10 Mluxh, Sample No. 3 (which has a layer which meets the compositional limitations of present claim 12) has enhanced light fastness properties compared to Sample No. 4 (which does not have a layer meeting the compositional limitations of present claim 12) for those samples printed with Printer HP 970, but does not have enhanced light fastness properties for those samples printed with Printer Epson SP 890. When exposed to a total illumination of 20 Mluxh, Sample No. 3 has enhanced light fastness properties compared to Sample No. 4 for those samples printed with Printer Epson SP 890, but does not have enhanced light fastness properties for those samples printed with Printer HP 970.

*Marie R. Yamnitzky*

MARIE YAMNITZKY  
PRIMARY EXAMINER

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